

REMARKS

This Amendment is being filed in response to the final Office action, mailed March 29, 2001, to which a request for reconsideration is respectfully being made in light of the following remarks.

Power of Attorney and Change of Correspondence Address of Record

The Examiner has refused entry of the power of attorney submitted with Applicant's previous response. The reason given is that the power of attorney does not indicate the withdrawal of the currently named attorney of record.

The Examiner did not provide a form paragraph or citation to the MPEP that authorizes the requirement, which implies that there is a rule that an applicant cannot name any new attorneys to prosecute an application without all previously named attorneys having withdrawn. This does not seem correct, and Applicant cannot find such a rule in the MPEP. Accordingly, Applicant respectfully requests that the Examiner identify the authority for the refusal.

Section 112 Rejections

Claims 2 - 3, and 10 - 11 stand rejected under the written description requirement of 35 USC §112. The shielding windings were introduced in error, and the claims have been amended to recite the original shielding layers.

The Examiner maintains the rejection of claims 7 - 8 and 14 - 15 under 35 USC §112, second paragraph.

The Meaning of the Words “Open” and “Loop”

The Examiner has disagreed with Applicant’s assertion that the terms “open” and “loop” possess their ordinary meanings. The Examiner refers to definitions (which did not accompany the Office action as indicated) for the phrase “open loop” as it is used in the electrical engineering arts. The undersigned is familiar with at least some of the uses to which the phrase “open loop” is put in electrical engineering. Typically, the term “open loop” is used in electrical engineering as an adjectival phrase, such as in “open loop control system,” or “open loop gain.” On the other hand, it is apparent from the grammar of the claims that the use of the terms “open” and “loop” therein is different.

Particularly, the phrase “an open loop [that is] positioned” means that a “loop” (noun) is recited as being positioned (somewhere), and the loop is described (adjective) as being “open.” It would not make sense to construe the entire phrase “open loop” as an adjective, because there would then not be a noun in the sentence for the alleged adjective to modify. Therefore, it is respectfully submitted that there is no reasonable basis for a person reading the claims to believe that the terms “open” and “loop” possess anything other than their ordinary meanings.

Relationship Between “Open Loop” and the Specification and Drawings

The Examiner asserts that “there is nothing in the specification to disclose the [claimed] ‘open loop’” Applicant points out that, even if this were true, it would not necessarily render the claim language indefinite. Regardless, Figure 10 shows a feature 82 that supports the claims, properly construed. The feature 82 meets the ordinary definition of the word “loop,” and it is shown as being “open” according to the ordinary definition of “open.” This is additional evidence that it is reasonable to construe the terms “open” and “loop” as having their ordinary meanings

The claims have been amended to clarify that the loop is formed of an electrically conductive material as suggested by the arrow in Figure 10 indicating current flow in the standard manner. It

is submitted that this clarification is not narrowing and is not being made for any reason of patentability, because the recited characteristic of the loop is inherent and would be understood by persons of ordinary skill in the absence of the amendment.

Section 103 Rejections

The Examiner disagrees with Applicant's assertion that the allegations (of obviousness) do not rise to the level of a *prima facie* case according to MPEP 2142. Applicant did not intend to accuse the Examiner of anything, and regrets her apparent perception to the contrary. However, Applicant has a right to insist that rejections meet the requirements of the MPEP, which defines the required *prima facie* showing as follows: "[T]he prior art reference (or references when combined) must teach or suggest *all* of the claim limitations." MPEP 2142 (emphasis added). It is respectfully submitted that, by comparing the allegations (A) with the claim elements (B), it is unambiguous that the required *prima facie* showing has not been made.

(A) The allegations are as follows:

"Godek discloses a printed circuit board of dielectric sheet 10; a first transformer having first core 82 extending through [the] dielectric sheet and a first set of electrically conductive windings 50; a second transformer having a second core 42 extending through [the] dielectric sheet and a second set of electrically conductive windings 32; and a conductive trace 22 communicating with a first set of conductive winding[s] [figure 4]. The . . . windings are encapsulated [figure 5]."

"Haertling discloses a multi layer transformer wherein the conductive element 256b are in between two adjoining layers 254, 256 of dielectric sheets [figure 12]. It would have been obvious to a person of ordinary skill in the art to have multi layer [sic] of dielectric sheets as taught by Haertling to Godek."

(B) The rejected claims require the following:

(1) "a multilayer printed circuit board having multiple layers of dielectric sheets;

(2) “a first transformer having . . . a first set of electrically conductive windings, at least one of . . . [which is] contained between two adjoining layers of said dielectric sheets”;

(3) “a second transformer having . . . a second set of electrically conductive windings, at least one of . . . [which is] contained between two adjoining layers of said dielectric sheets”; and

(4) “[an] electrically conductive trace extending between said first set of electrically conductive windings and said second set of electrically conductive windings.”

Taking all of the allegations as true (for purposes of argument only), it is seen by comparing (A) with (B) that there is no allegation that the prior art teaches or suggests claim element (B)(4). Therefore, there is no *prima facie* showing according to the rules.

The Examiner states that Applicant’s “failure to challenge the examiner’s assertion . . . can only mean the applicant acquiesces to the examiner’s position” This is not a logical conclusion. Applicant has stated that, in his view, no *prima facie* showing was made, and MPEP 2142 provides that applicants are under no obligation to respond to such allegations of obviousness, because even if all such allegations are true, they are insufficient to show that the claims are unpatentable.

In light of the above, it is respectfully submitted that the final rejections under 35 USC §103 are premature. Accordingly, the Examiner is respectfully requested either to withdraw the rejections, or produce the required *prima facie* case to support the rejections and issue a non-final action giving Applicant a fair opportunity to respond to the *prima facie* case.

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The amendments are simply to clarify the claim language and have not been made to overcome prior art. Applicant respectfully submits these clarifications only remove or simplify issues for appeal and do not raise any issues requiring search, and it is therefore respectfully requested that the Amendment be entered even if the Examiner disagrees with Applicant's position on the rejections under 35 USC §103. However, Applicant respectfully submits that the claims are in condition for allowance, and the Examiner is respectfully requested to reconsider the rejections, allow claims 1 - 15, and pass this case to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Garth Janke", is written over the typed name.

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